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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNOLD G. SLEZAK

Appeal 2009-000747
Application 09/981,556
Technology Center 3700

Decided: August 28, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Arnold G. Slezak (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3, 5-9, and 21. Claims 22-24 were objected to as being dependent on a rejected base claim. We have jurisdiction under

35 U.S.C. § 6(b) (2002). An oral hearing with Appellant's counsel occurred on June 25, 2009.

The Invention

The disclosed invention is to method for assembling prewritten discs in a disc stack that minimizes servo pattern runout. Spec. 3:6-7.

When servo information is written onto a disc, three radial lines are made on both the upper and lower surfaces. The middle line is an alignment mark. Spec. 5:11-13.

The assembly process of the disc stack starts by placing a prewritten disc about the spindle motor hub of a disc drive. A detector scans the prewritten disc to locate the alignment mark. The prewritten disc is then rotated and aligned with the assistance of a biasing force that is applied to the outside edge of the disc toward its center. The position of the prewritten disc is then secured to the spindle by a disc clamp. The process continues by placing the next prewritten disc about the spindle and the additional step of balancing the disc stack by applying the biasing force at opposite directions for even numbered disc stack assemblies or at even intervals for odd numbered disc stack assemblies. Spec. 6:16 to 7:30.

Illustrative Claim

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method comprising:

placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc, around a motor hub, the prewritten discs placed with respect to each other disposing the angular reference axes symmetrically around the motor hub; and

biasing each disc in a direction of the respective angular reference axis to concentrically align the servo tracks of a first disc of the prewritten discs with the servo tracks of a second disc of the prewritten discs.

SUMMARY OF DECISION

We REVERSE and ENTER A NEW GROUND OF REJECTION
PURSUANT TO OUR AUTHORITY UNDER 37 C.F.R. § 41.50(b).

ANALYSIS

For the reasons set forth subsequently in this opinion, the existing prior art rejections are reversed, *pro forma*, because they necessarily are based upon speculative assumptions as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect the adequacy or inadequacy of the prior art evidence supplied in support of the rejections of record.

NEW REJECTION UNDER 37 C.F.R. § 41.50(b)

Claims 1, 3, 5-9, and 21-24 are rejected under the second paragraph of 35 U.S.C. § 112 as being vague and indefinite and essentially failing to set forth the subject matter which Appellant regards as his invention.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety*

Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

The claims are directed to a process of placing prewritten discs having servo tracks that are “offset in relation to a common angular reference axis of each disc” around a motor hub. The prewritten discs are placed with respect to each other “disposing the angular reference axes around the motor hub” and biasing each disc in a direction of the respective angular reference axis to concentrically align the servo tracks of the prewritten discs.

The Specification describes a process placing a prewritten disc about the spindle motor hub of a disc drive. A detector scans the prewritten disc to locate the alignment mark. The prewritten disc is then rotated and aligned with the assistance of a biasing force that is applied to the outside edge of the disc toward its center. The position of the prewritten disc is then secured to the spindle by a disc clamp. The process continues by placing the next prewritten disc about the spindle and balancing the disc stack by applying the biasing forces in other directions that are dependent on the number of discs which will form the assembly.

A person having ordinary skill in the art would not understand what is claimed when claims are read in light of the Specification. The claims recite the prewritten discs have servo tracks that are “are offset in relation to a common angular reference axis of each disc” and the discs are placed “disposing the angular reference axes symmetrically around” the motor hub. The Specification describes a process of locating an alignment mark on a prewritten disc and rotating and aligning the prewritten disc with a biasing force in a direction toward the center of the disc. The Specification does not describe the Appellant’s invention in terms of a “common angular reference

axis,” and a person of ordinary skill in the art would not understand what axis is being referred to. For example, “common angular reference axis” could refer to a common cylindrical axis (viewing Figure 2, an axis radiating through the page), a polar axis (viewing Figure 2, an axis that rotates around the disc like a hand of a clock) or a common rectangular axis lying in the plane of the page on which Figure 2 appears, and the Specification does not provide adequate guidance to as the proper coordinate system to use to place this claimed phrase in context. As such, a person of ordinary skill in the art would not understand the scope of the claims in light of the Specification because the claims terms are not sufficiently described in the Specification.

Accordingly, the scope of meaning of the claims is undeterminable, subject to plural interpretations, and therefore indefinite. Furthermore, the notice requirement of 35 U.S.C. § 112, second paragraph, appears not to have been met to permit the public to reasonably avoid potential infringement of any claim that may be issued. Moreover, the claims, as drafted, fail to provide a clear measure of what Appellant regards as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the Specification meets the criteria of 35 U.S.C. § 112, first paragraph, with respect to the claimed invention.

SUMMARY

In view of the foregoing, we have *pro forma* reversed the Examiner’s prior art rejections of all claims on appeal. We have entered a new ground of rejection of claims 1, 3, 5-9, and 21-24 under 35 U.S.C. § 112, second paragraph.

DECISION

The Examiner's decision to reject the claims on appeal under 35 U.S.C. §§ 102(b) and 103(a) is *pro forma* reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

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LV

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